

REMARKS

In the present response to the outstanding Official Action, claims 18 and 55 have been amended and new claims 56 and 57 has been added. Claim 18 has been amended to recite that the particles are now selected from the group consisting of solid particles and porous particles, and the term "non-hollow" has been deleted from the claim. Support for this amendment can be found on page 8, lines 26-28. Additionally, the phrase "comprising a substantially...non-adhesive....non-hollow" has been deleted from claim 18. Claim 55 has been amended to remove the redundant wherein clause and claim 56 has been added to add that the substrate is substantially rigid.

Claim Rejections Under 35 U.S.C. § 112

Claims 18-25, 27-34 and 55 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor at the time the application was filed had possession of the claimed invention. Specifically, the PTO objects to the term "non-hollow" in claim 18 as being new matter. To alleviate this objection, Applicant has deleted the term "non-hollow" and inserted the phrase that the particles are selected from the group consisting of solid particles and porous particles. As previously mentioned, support for this amendment can be found on page 8, lines 26-28.

Additionally, claims 18-25, 27-34 and 55 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The PTO has objected to the phrase "comprising a substantially...non-adhesives...non-hollow" as being vague and indefinite. Applicant has amended claim 18 such that the phrases "comprising a substantially non-stringing

adhesive,” “comprises substantially non-adhesive particles” and “substantially non-adhesive particles are non-hollow” have been deleted from the claim. The claim now recites that “the barrier layer comprises a plurality of particles, the particles being substantially non-adhesive.” Again, the claim no longer includes the term “non-hollow.” Thus, Applicant respectfully asserts that the claim rejections under 35 U.S.C. § 112 have been alleviated.

Claim Objections Under 35 U.S.C. § 103(a)

Claims 18-25, 27-34 and 55 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Keely et al.* in view of the admitted art. The PTO states that the term “comprising” in claim 18 is an open-ended term such that the claims fail to exclude the hollow glass beads of *Keely et al.* Furthermore, the PTO maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to select an optimized combination of crushable particles for the barrier layer and suitable pressure sensitive adhesives with the proper thermal properties to make the surface covering.

In response to Applicant’s argument that *Keely et al.* does not teach or suggest the use of other than hollow glass beads embedded into the adhesive layer, the PTO has maintained that Applicant’s previous amendment to claim 18 recites “comprising” as an open-ended term such that the claims fail to exclude the hollow glass beads of *Keely et al.* Applicant respectfully points out that the Examiner is confusing the standard for infringement and the standard for patentability. The claim does not have to exclude the hollow glass beads of *Keely et al.*, since *Keely et al.* do not teach the use of solid or porous particles.

genus
→ species

In response to the Examiner’s rejection, Applicant has amended claim 18 such that the particles are now recited to be selected from the group consisting of solid particles and porous particles. Consisting is a closed-end term such that the particles must be comprised of solid or

porous particles, thus they may not be made from hollow glass beads. Thus, *Keely et al.* does not teach or suggest that which is claimed in the present claims. *Keely et al.* exclusively teaches the use of hollow glass beads, whereas the present claims require the particles to include solid or porous particles. Thus, one of ordinary skill in the art would not have modified that taught in *Keely et al.* to render obvious the present application.

New claim 56 has been added in response to the Examiner's comment set forth in the fourth paragraph of section 4 of Paper No.15. Claim 56 requires the substrate to be substantially rigid.

New claim 57 has been added to specifically address the issue whether rewritten claim 18, which permits the addition of hollow particles to the required solid or porous particles, is patentable over the prior art. Again, *Keely et al.* exclusively teaches the use of hollow glass beads, whereas the present claims require the particles to include solid or porous particles. The admitted prior art does not teach or suggest the combination of hollow particles with either solid particles or porous particles and the barrier layer exhibiting the specified crush resistance.

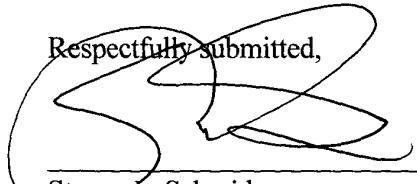
CONCLUSION

Upon entry of the above Amendment, claims 18-25, 27-34, 55-57 remain pending in the present application. Applicant urges that the present application is now in a condition for allowance and an early notice to such effect is earnestly solicited. However, if it is believed that

any issues remain unresolved in the present application, Applicant requests that the Examiner contact the undersigned.

3/4/03
Date

Respectfully submitted,



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Cheryl West

APPENDIX

18. (Three Times Amended) A self-adhering surface covering comprising:

a substrate;

a pressure-sensitive adhesive layer disposed on the substrate and having an adhesive surface [distal] located distally from the substrate, the adhesive layer comprising [a substantially non-stringing] an adhesive, the adhesive being substantially non-stringing; and

a barrier layer disposed substantially on and covering between about 1% [to] and about 10% of the adhesive surface, wherein the barrier layer comprises [substantially non-adhesive] a plurality of particles [exhibiting], the particles being substantially non-adhesive, wherein the barrier layer exhibits a crush resistance of at least about 10 psi, and wherein the [substantially non-adhesive] particles are [non-hollow] selected from the group consisting of solid particles, porous particles and combinations thereof.

55. (Amended) The surface covering of claim 18, wherein the non-adhesive particles are selected from the group consisting of calcium carbonate, barium carbonate, calcium sulfate, barium sulfate, aluminum sulfate, molybdenum disulfide, titanium oxide, aluminum hydroxide, alumina, silica, magnesium oxide, calcium oxide, calcium hydroxide, ferrous oxide, ferric oxide, cured rubbers, ebonite, resins, and combinations thereof[, wherein the substantially non-adhesive particles exhibit a crush resistance of at least about 10 psi].

56. (NEW) The surface covering of claim 18, wherein the substrate is substantially rigid.

57. (NEW) The surface covering of claim 18, wherein the barrier layer further comprises a second plurality of particles, the particles of the second plurality being substantially non-adhesive hollow particles.